

REMARKS

Status of Claims

Claims 1-61 are pending. Claims 14, 27, and 60 are withdrawn from consideration. No amendments have been made.

Information Disclosure Statement

Applicants thank the Examiner for pointing out the discrepancy concerning WO 02/42290 and WO 2004/042290 with regard to the Information Disclosure Statement filed 2 October 2008. Applicants filed a Letter dated 13 March 2009 explaining that WO 2004/042290 was listed in error and that WO 02/42290 is the reference that Applicants wish to consider. Applicants concurrently file an Information Disclosure Statement that cites WO 02/42290, as well as the Office Actions for related pending applications. Applicants kindly request that the Examiner consider this and the other references cited in the Information Disclosure Statement.

Withdrawn Rejections

Applicants note that the Examiner wrote in the Office Action dated 5 December 2008 at page 3 that "[r]ejections and/or objections not reiterated from the previous Office Action are hereby withdrawn." Applicants interpret this passage to mean that because the 5 December 2008 Office Action does not include a rejection under 35 U.S.C. § 103(a) over Schumacher (U.S. Patent No. 6,506,767) then this rejection has been formally withdrawn.¹ Clarification is requested.

Double Patenting

Applicants respectfully request that the provisional obviousness-type double patenting rejection of claims 1-3, 15-26, 28-59, and 61 over claims 21-24 of 11/283,276 be held in abeyance until there is an indication of allowable subject matter in the present application.

Claims Rejections – 35 U.S.C. § 102

The Office has taken the position that claims 1-13, 15-26, 28-59, and 61 are unpatentable under 35 U.S.C. §102(b) as being *inherently* anticipated by:

- (1) Villani (U.S. Patent No. 4,659,716), as evidenced by Schumacher;
- (2) Schumacher '855 (EP 0 208 855), as evidenced by Schumacher; and

¹ The claims had been previously rejected under 35 U.S.C. §103(a) over Schumacher in the 21 August 2006 Office Action (see pages 9ff) and in the 16 July 2007 Office Action (see page 6ff).

(3) Piwinski (WO 92/002293) as evidenced by the arguments filed by Quimica Sintetica, S.A. in the Notice of Opposition to European Patent 1 507 531, and further evidenced by the Excerpt from the Opposition proceedings concerning EP 0 993455.

Applicants note that with respect to the outstanding issue, the subject matter of Villani is substantially the same as the subject matter of Schumacher '855. Thus, the rejection based on Schumacher '855 is redundant in view of the rejection based on Villani.² Applicants invite the Examiner to compare the relevant disclosure of Villani to the relevant disclosure of Schumacher '855. For convenience, Applicants have reproduced the text of these two documents below with the substantive differences underlined.³

Villani (U.S. 4,659,716)	Schumacher '855 (EP 0 208 855)
Col. 17, line 63 – col. 18, line 7 EXAMPLE V	Page 29 EXAMPLE V
8-Chloro-6,11-dihydro-11-(4-piperidylidene)-5H-benzo[5,6]cyclohepta[1,2-b]pyridine	8-Chloro-6,11-dihydro-11-(4-piperidylidene)-5H-benzo[5,6]cyclohepta[1,2-b]pyridine
The acetic acid salt prepared as in <u>Example II</u> is dissolved in a minimum amount of water and the solution is made basic with a dilute aqueous solution of potassium carbonate. A pink colored oil separates.	The acetic acid salt prepared in <u>Example III</u> is dissolved in a minimum amount of water and the solution is made basic with a dilute aqueous solution of potassium carbonate. A pink colored oil separates.
Extract the organic material with chloroform, wash with water and remove the solvent. Triturate the residue with hexane. Recrystallize from a large volume of hexane after charcoal decolorization to obtain the product, m.p. 151°-152°C.	Extract the organic material with chloroform, wash with water and remove the solvent. Triturate the residue with hexane. Recrystallize from a large volume of hexane after charcoal decolorization to obtain the product, m.p. 151-152°C.
Col. 18, ll. 34-51 B.	Page 30 B.
8-Chloro-6,11-dihydro-11-(4-piperidylidene)-5H-benzo[5,6]cyclohepta[1,2-b]pyridine.	8-Chloro-6,11-dihydro-11-(4-piperidylidene)-5H-benzo[5,6]cyclohepta[1,2-b]pyridine.
A solution of 14 grams of the N-cyano compound from part A in 60 mL of concentrated hydrochloric acid, 600 mL of glacial acetic acid and 400 mL of water is refluxed with stirring for 20 hours. The solvents are removed in vacuo and the residue dissolved in water and neutralized with ammonium hydroxide. The material is extracted several times with chloroform, the chloroform extracts washed with water and concentrated to dryness, and the residue triturated with petroleum ether or hexane to yield 11.5 grams (93%) m.p. 149°-151°C. After	A solution of 14 grams of the N-cyano compound from part A in 60 mL of concentrated hydrochloric acid, 600 mL of glacial acetic acid and 400 mL of water is refluxed with stirring for 20 hours. The solvents are removed in vacuo and the residue dissolved in water and neutralized with ammonium hydroxide. The material is extracted several times with chloroform, the chloroform extracts washed with water and concentrated to dryness, and the residue triturated with petroleum ether or hexane to yield 11.5 grams (93%) m.p. 149-151°C. After

² Applicants note that Schumacher '855 claims priority to three U.S. non-provisional applications: (1) 06/733,428, filed 13 May 1985, (2) 06/838,974, filed 12 March 1986, and (3) 06/839,974, filed 12 March 1986. Incidentally, Villani issued from 06/838,974, filed 12 March 1986.

³ Villani's reference to Example II is incorrect, while Schumacher '855's reference to Example III is correct.

Villani (U.S. 4,659,716)	Schumacher '855 (EP 0 208 855)
recrystallization from hexane, the product melts at 150°-151°C.	recrystallization from hexane, the product melts at 150-151°C.
Anal. Calcd. for C ₁₉ H ₁₉ N ₂ Cl: C,73.42; H,6.16; N,9.01. Found: C,73.19; H,6.14; N,8.91.	Anal. Calcd. for C ₁₉ H ₁₉ N ₂ Cl: C,73.42; H,6.16; N,9.01. Found: C,73.19; H,6.14; N,8.91.

Applicants believe that the disclosures of Villani, Schumacher '855 and Piwinski do not inherently anticipate the claims of the present application. Applicants intend to file a Declaration under 37 CFR 1.132 shortly in support of this position.

Applicants believe that withdrawal of these rejections is warranted, and ask that the Examiner acknowledge the same.

Procedural Matters

Applicants concurrently file with the present response a Request for a Three-Month Extension of Time under 37 CFR 1.136(a) with an authorization to charge the requisite fee under 37 CFR 1.17(a)(3) to Applicants' representative Deposit Account 13-2725. If for any reason the Request is separated from the present response, then Applicants authorize the Office to charge the above-noted Deposit Account to pay any necessary fees so as to maintain the pendency of the present application.

In view of the remarks contained herein, Applicants respectfully request a Notice of Allowance. If the Examiner believes that a discussion would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.



Respectfully submitted,
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A handwritten signature in black ink that reads "Daniel R. Evans". The signature is written in a cursive, flowing style.

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Date: **June 5, 2009**